

23 JUN 2006



UNITED STATES PATENT and TRADEMARK OFFICE



COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

STITES & HARBISON PLLC  
1199 NORTH FAIRFAX STREET  
SUITE 900  
ALEXANDRIA VA 22314

In re Application of	:	DECISION ON
David JEAL et al	:	
PCT No.: PCT/GB03/004377	:	
Application No: 10/531,431	:	
Int. Filing Date: 09 October 2003	:	PETITION UNDER
Priority Date: 17 October 2002	:	
Attorney's Docket No.: P08629US01/BAS	:	
For: FACILITAING AND AUTHENTICATING	:	
TRANSACTIONS	:	37 CFR 1.47(a)

This is in response to the "PETITION UNDER 37 CFR 1.47(a)" filed on 13 March 2006. The petition fee of \$200.00 has been paid by credit card.

**BACKGROUND**

On 09 October 2003, applicants filed international application PCT/GB03/004377, which claimed priority to an earlier application filed 17 October 2002. A copy of the international application was communicated by the International Bureau to the United States Patent and Trademark Office on 29 April 2004. The thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 17 April 2005.

On 15 April 2005, applicants filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed declaration or oath was submitted at such time.

On 12 January 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905), which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date." The notice indicated that all of the items set forth must be submitted within two (2) months from the date of this Notice or by 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment.

On 13 March 2006, petitioner filed the present petition, a declaration in support of filing on behalf of the nonsigning inventor, George Mudie. However, no executed Declaration signed by David Jeal on his behalf and the behalf of the nonsigning inventor George Mudie was found with the accompanied papers.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

#### **REFUSAL TO JOIN:**

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied items (1) and (3) of 37 CFR 1.47(a) but not items (2) and (4).

Regarding item (1), petitioner has provided the fee under 37 CFR 1.17(g).

Regarding item (2), in this case, Mr. Schulman has not sufficiently demonstrated that a complete copy of the application papers were presented to the non-signing inventor, George Mudie. Petitioner has not stated that the complete copy of the application papers (specification, including claims, drawings, and oath or declaration) were sent to Mr. Mudie and that he refused to sign the required papers as stipulated under MPEP 409.03(d). The declaration of Mr. Harris only refers to the Oath and the assignment being sent to Mr. Mudie and is silent on the other parts of application papers because fully Mr. Mudie is considered to be fully aware of the specification of this U.S. patent application. However, the rule is specific that a complete copy of the application be mailed to the nonsigning inventor for his review.

In addition, it is unclear from the copy of the courier tracking information if Mr. Mudie received the correspondence because it neither shows that it was signed by Mr. Mudie at the time of receipt nor the does tracking information show the address that the correspondence was delivered. Also, no cover letter of the correspondence has been submitted.

Accordingly, the steps enumerated by Mr. Schulman are not sufficient to establish that Mr. Mudie has refused to sign the declaration.

Regarding item (3), petitioner has provided a statement of the last known address of the missing inventor.

Regarding item (4), a review of the petition and its accompanied papers does not show that the executed declaration was with them.

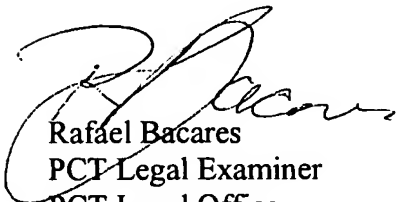
Consequently, the petition does not satisfy all the items under 37 CFR 1.47(a).

**CONCLUSION**

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Telephone: (571) 272-3276  
Facsimile: (571) 273-0459